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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,009	11/08/1999	CAROL MORRIS	047763-5010	3768

9629 7590 11/16/2004
MORGAN LEWIS & BOCKIUS LLP
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WASHINGTON, DC 20004

EXAMINER

DAVIS, MINH TAM B

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/367,009	Applicant(s) MORRIS ET AL.	
	Examiner MINH-TAM DAVIS	Art Unit 1642	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 11 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 102 rejection.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 15 and 21-27.

Claim(s) rejected: 13-14, 16-20.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Accordingly, claims 13-27 are being examined.

It is noted that claims 1,3,6-12 were cancelled in the amendment of May 06, 2003, and claim 5 was cancelled in the amendment of August 22, 2002, and that Applicant's reference to claims 1, 3, 5-8, 10-11 concerning arguments against the rejection under 102(a) is not applicable.

It is further noted that rejection under 35 USC 102(a) of claims 13-15, 21-27 has been withdrawn in view of the submission of the certified copy of the priority application.

The following are the remaining rejections.

OBJECTION

Claims 15, 21-27 appear to be free of prior art but are objected to as being dependent upon a rejected base claims, but would be allowable if rewritten in independent forms, including all of the limitations of the base claim and any intervening claims.

REJECTION UNDER 35 USC 112, FIRST PARAGRAPH, WRITTEN DESCRIPTION

Rejection under 35 USC 112, first paragraph of claims 16-20 pertaining to lack of a clear written description of the structure of the epitope or the N-terminus sequence to

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which the label or the antibody of the claimed method binds to, remains for reasons already of record in paper of 07/02/03.

Rejection remains because Applicant did not answer to the rejection.

REJECTION UNDER 35 USC 112, FIRST PARAGRAPH, SCOPE

1. Rejection under 35 USC 112, first paragraph of claims 16-20 pertaining to lack of enablement for a method for screening cancer, comprising detecting the presence of a protein having a molecular weight of about 10 kD, and a pI of about 5.1, wherein "the protein is detected by a probe that binds to any part of the protein, or any part of the N-terminus of the protein" or "detected by an antibody that specifically binds to the protein", remains for reasons already of record in paper of 07/02/03.

Rejection remains because Applicant did not answer to the rejection.

2. Rejection under 35 USC 112, first paragraph of claims 13-14 pertaining to lack of enablement for a method for screening cancer, comprising detecting the presence of a protein having a molecular weight of about 10 kD, and a pI of about 5.1, wherein "the protein is detected by electrophoresis", remains for reasons already of record in paper of 07/02/03.

Rejection remains because Applicant did not answer to the rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 8:30AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MINH TAM DAVIS
November 03, 2004

SUSAN UNGAR, PH.D.
PRIMARY EXAMINER

